



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,787	01/27/2004	Mary M. DaRif	6962D1	2596

7590 06/09/2005  
 The Sherwin-Williams Company  
 11 Midland Bldg. - Legal Dept.  
 101 Prospect Avenue, N.W.  
 Cleveland, OH 44115

EXAMINER

GREEN, BRIAN

ART UNIT PAPER NUMBER

3611

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/765,787

Applicant(s)

DARIF ET AL.

Examiner

Brian K. Green

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 25-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

**The status identifier for claims 25-28 should be “(previously presented)” since these claims were added in the amendment filed on Jan. 27, 2004.**

Applicant is advised that should claim 28 be found allowable, claim 31 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

#### ***Claim Rejections - 35 USC § 112***

Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 is misdescriptive since it is not understood how a tear line can have ends separated by a space which is not perforated as defined by the applicant. In the applicant's invention, the tear line would have to include three tear lines, see figure 4.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25 and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Crosslen (U.S. Patent No. 4,265,038) and Teter et al. (U.S. Patent No. 6,112,665).

The applicant's admitted prior art in the specification page 1, lines 19-27 and page 2, lines 10-14 discloses the idea of placing paint chips within a rack and the idea of using paint chips with a plurality of color samples on a single card and the idea of covering a paint chip with a single color. The applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 does not disclose whether the display rack includes a wall which covers a chip section and the idea of placing perforations in the card to form a paint chip section.

Crosslen shows in figures 1-7 the idea of placing paint color cards (5) within pockets formed on a display rack which includes walls (7,30). In view of the teachings of Crosslen it would have been obvious to one in the art to modify the applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 by placing the paint color card on a display rack which includes walls since this would help to protect the cards from being damaged and would help to hold the cards in a more secure manner. When the paint color card of the applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 is placed within one of the pockets of Crosslen some of the chip sections would be covered by the walls (7,30). Further, from the back side, the entire color card would be covered by the walls (7,30) and hence the chip sections would be completely covered. Teter et al. shows in figures 4 and 5 the idea of placing perforations (14) within a colored section in order to allow the perforated area to be removed. In view of the teachings of Teter et al. it would have been obvious to one in the art to modify the applicant's admitted prior art in the specification page 1, lines 19-27 and page 2, lines

Art Unit: 3611

10-14 by adding perforations to the color card to form a chip section since this would allow an opening to be formed within the color coated card which would allow better color matching to be performed, as taught by Teter et al., column 4, lines 55-65. In regard to claim 17, the applicant's admitted prior art in the specification page 1, lines 10-18 discloses the idea of using paint color cards having a plurality of colors on each card. The chip section formed by the perforations would be smaller in every direction than the chip sections of the paint color card. In regard to claim 18, there is a space between the perforations of Teter et al. and the chip section could be folded along any one of the spaces as broadly defined. In regard to claims 19, 28, and 31, Teter et al. discloses the use of a plurality of tear lines which would allow the chip section to be removed from the rest of the card. In regard to claim 25, the applicant's admitted prior art in the specification page 2, lines 10-14 discloses the idea of using paint color cards having an entire surface of the card colored with a single paint color. In regard to claim 29, the applicant discloses in the specification on page 1, lines 10-15 that the use of color cards having multiple colors on each card is known in the art and also discloses in the specification on page 1, lines 23-25 that it is known to place these color cards into racks. It would have been obvious to one in the art to modify the applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 since this would allow a wider range of paint chip cards to be held and displayed in a single rack. Teter et al. discloses making the chip section small so the color swatches on the color strip would have a size greater in every direction than the chip section of the paint color card. In regard to claim 30, as best understood, the applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Crosslen and Teter et al. does not disclose placing an unperforated space between the tear lines and including a fold line in the

Art Unit: 3611

unperforated space. It would have been an obvious matter of design choice to modify applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Crosslen and Teter et al. by making a space between the tear lines non-perforated since the applicant fails to define any advantage to making the space non-perforated and the perforated space defined by Teter et al. would work equally well. Further, the chip section taught by Teter et al. could be partially separated from the rest of the card and pivoted along the remaining attached perforated section.

Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Crosslen (U.S. Patent No. 4,265,038) and Teter et al. (U.S. Patent No. 6,112,665) as applied to claim 25 above and further in view of Edwards (U.S. Patent No. 4,992,050) or Goldsholl (U.S. Patent No. 3,224,113).

The applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 in view of Crosslen and Teter et al. disclose the applicant's basic inventive concept except for placing a color coating on the back of each chip section. Edwards discloses in the abstract the idea of placing a first color of paint on a first side of a chip section and a coating of paint on the opposite side of each chip section. Edwards discloses that the paint on the second side has a different finish as compared to the first side. Goldsholl discloses in column 1, lines 59-62, the idea of placing paint on the front and back surfaces of a paint card. In view of the teachings of Edwards or Goldsholl it would have been obvious to one in the art to modify applicant's admitted prior art in the specification page 1, lines 10-27 and page 2, lines 10-14 by placing a

Art Unit: 3611

coat of paint on the second surface of each chip section since this would allow more colors/finishes to be displayed by the color card. In regard to claim 26, it is considered within one skilled in art to place the same color on the back of each chip section as on the front since this would allow the color of the paint to be seen on either side of the chip section, i.e. easier and quicker to determine the paint color shown by the color card. In regard to claim 27, the colors on each side of the paint chip sections of Edwards are considered to be of the same color but would have different compositions. Further, as indicated above, placing a coat of paint on the second surface of each chip section would allow more colors to be displayed by the card, i.e. one color on the front of the card and a second color on the back of the card. Also, when different finishes are used the colors would be slightly different.

### ***Response to Arguments***

Applicant's arguments filed March 15, 2005 have been fully considered but some of the arguments are not persuasive.

The applicant argues that there is absolutely no suggestion or motivation to combine the two teachings (applicant's admitted art in view of Teter et al.) that the examiner has used to make the rejection of claim 25. The examiner disagrees since Teter et al. discloses in column 4, lines 55-64, that placing a hole in the color card provides a clear advantage to a color card without a hole, i.e. "the swatch cards can be conveniently laid on top of a printed card or product sample in order to obtain the best match possible. Placing the swatches over a product whose color is to be matched and viewing the product color through the hole is preferable to simply

Art Unit: 3611

laying a swatch next to the color to be matched, as the visual perception is more accurate when the color being matched appears through a hole”.

The applicant argues that Teter et al. specifically teaches the use of a color card with a plurality of color swatches and there is no suggestion to use the device of Teter et al. with a single color card. The examiner disagrees since the applicant already discloses that the use of a single color card is known in the art. Teter et al. discloses that it is advantageous to place a hole in a color card. Placing a hole in the applicant's admitted prior art, as taught by Teter et al., would allow for better matching as taught to be desirable by Teter et al.. In view of the teachings of Teter et al. it is considered within one skilled in the art to place an aperture/hole in any type of color card in order to achieve the advantage taught by Teter et al.

In regard to the applicant's argument that Teter et al. does not contemplate that the color on the swatches are formulated to have a dried color that is substantially similar to the dried color of a commercially available paint composition. The color on the color card of the applicant's admitted prior art would inherently match the color of a commercially available paint composition, i.e. that's the purpose of the color card. Whether the colors on the Teter et al. reference match a commercially available paint composition is immaterial.

The applicant argues that Crosslen fails to disclose covering the chip section with a wall as defined in claim 25. Crosslen can be interpreted to read on claim 25 in two ways. First, it depends upon where the chip section is placed on the color card. When the chip section is placed on a lower portion of the color card than the walls (7,30) of Crosslen would cover most or all of the chip section. Second, when Crosslen is viewed from the left in figures 5-7, the walls (7,30) cover the entire color card so they would inherently cover the entire chip section.



***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (571) 272-6644. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bkg  
June 1, 2005

  
BRIAN K. GREEN  
PRIMARY EXAMINER